



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/322,073	05/27/1999	MICHAEL F. GUHEEN	AND1P103	7477

7590 11/04/2004

MERCHANT & GOULD P.C.
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/322,073

Applicant(s)

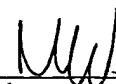
GUHEEN ET AL.

Examiner

Robert M. Pond

Art Unit

3625



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-10 and 12-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-10, and 12-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to the Amendment

The Applicant amended independent Claims 1, 9, and 17. All pending claims (1, 2, 4-10, and 12-17) were examined in this non-final Office Action necessitated by new grounds of rejection under 35 USC 101.

Response to the Arguments

Rejection under 35 USC 103(a), Claims 1, 2, 4-10, and 12-17

Applicant's arguments filed 09 July 2004 have been fully considered but they are not persuasive.

The Applicant amended independent Claims 1, 9, and 17 and based arguments on the amended claims. The Applicant argues:

- ***Ruffin allegation implies that "islands of IT" correspond to "targeted components:"***

The Applicant is treating Ruffin in piecemeal fashion. Islands of IT are identified but are not solely relied upon by the Examiner in the Office Action. The Examiner cites the system and method of Ruffin making determinations that identify framework components within islands of IT as targets for modification.

- ***Ruffin does not teach or even suggest "determining a listing of targeted components that relate to the improvements to the existing network***

framework, wherein each targeted component offers one of the least one of the products and services for sale to the target market.”

Claim 1(c) reads: “determining a listing of targeted components that relate to the improvements to the existing network framework,”: Ruffin teaches determining components that require at least modification to the existing network framework.

Claim 1(c) further reads as amended: “wherein each targeted component offers one of the least one of the products and services for sale to the target market;” Ruffin clearly relates components targeted for improvement with products or services offered pertaining to the targeted components.

Rejection under 35 USC 103(a), Claims 5-7 and 13-15

Applicant's arguments filed 09 July 2004 have been fully considered but they are not persuasive. The Applicant argued the dependent claims as relying of arguments presented for independent Claims 1, 9, and 17. The Examiner respectfully disagrees with the Applicant for the reasons stated above.

Official Notice (ON1) (regarding IT business services)

The Applicant did not traverse the examiner's assertion of official notice. The common knowledge or well-known in the art statement is taken to be admitted prior art because applicant failed to traverse or adequately traverse the examiner's assertion of official notice (MPEP 2144.03(C)).

Official Notice (ON2) (regarding techniques to provide visual clarity to illustrations)

The Applicant did not traverse the examiner's assertion of official notice. The common knowledge or well-known in the art statement is taken to be admitted prior art because applicant failed to traverse or adequately traverse the examiner's assertion of official notice (MPEP 2144.03(C)).

Well Within the Skill (regarding pictorial representation of network framework)

The Applicant did not traverse the examiner's assertion of well within the skill. The common knowledge statement is taken to be admitted prior art because the applicant failed to traverse or adequately traverse the examiner's assertion.

Well Within the Skill (regarding modifying pictorial representation of network framework with indicia coding)

The Applicant did not traverse the examiner's assertion of well within the skill. The common knowledge statement is taken to be admitted prior art because the applicant failed to traverse or adequately traverse the examiner's assertion.

Rejection under 35 USC 101

New grounds of rejection were issued as a result of a 101 panel member review.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

- 1. Claims 1-8 and 17 are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.**

The claims are directed to a process that does nothing more than manipulate an abstract idea. Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea. There is no practical application in the technological arts to support the core invention. For subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *In re Alappat* 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond V. Diehr*, 450 U.S. at 192, 209 USPQ at 10). A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452.

Regarding program code Claims 9, 10, and 12-16

The Examiner views the computer program embodied on a computer readable medium in combination with code segments performing methods as meeting statutory subject matter as implying the execution of code segments.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-2, 4, 8-10, 12, and 16-17 are rejected under 35 USC 103(a) as being unpatentable over Ruffin et al. (Paper #10, patent number 6,249,769).**

Ruffin et al. teach an automated method for evaluating particular aspects of a business enterprise's environment and information technology (IT) infrastructure.

(please see at least title; abstract; col. 1, line 1-22). Ruffin et al. further teach:

- *Determining an existing network framework*: determination of any type of business solution offered by a solutions provider, be it in the area of information technology (IT); use IT in the form of an automated set of electronic questionnaires tied to modeling tools and a knowledge base used to assist in addressing issues; the ideal automated solution enables the implementation of a series of assessments processes designed to

ensure that the proper analysis is conducted; software programs for determining factors such as architecture; determining applications in the framework (e.g. e-business, ERP) (please note the examiner's interpretation: tools and processes used in determining e-business applications or ERP application would determine web-based applications) (see at least col. 3, lines 1-25; col. 4, lines 40-50; col. 5, lines 35-67).

- Defining a plan for selling at least one of products or services: qualifying a prospective customer (see at least col. 2, lines 5-29); a tool further comprises services for providing a sampling of the beneficial results which the customer may expect from the proffered solution (see at least col. 3, lines 49-54); the opportunity tool set generates business solution deliverables including a proposal for the enhancement of the information technology partition in accordance with the requirements articulated by the customer (see at least col. 4, lines 53-58).
- Determining a list of targeted components related to improvements: ordered listing of potential projects (see at least col. 7, lines 36-65); identifying "islands of IT," and servers for consolidation (please note the server consolidation example identifies the existence of Unix-based servers Type 1 servers, and the absence of an additional S/390 Type 2 servers (see at least Fig. 6 (601-616); col. 10, line 29 through col. 12, line 17).

- Determining a listing of necessary products or services (at least one):
generating a business deliverable in the form of a proposal (see at least col. 7, lines 66 through col. 8, line 8); matching the business entity's needs to a set of IT solutions as related to improvements (see at least abstract; Fig. 8 (806); col. 12, lines 26 through col. 15, line 45; col. 23, lines 15-16).
- Presenting a legend: pictorial representation featuring indicia coding with respect to products solution (see Fig. 7 (700); col. 12, lines 18-25).
- Displaying a pictorial representation of the existing network framework:

Ruffin et al. teach all the above as noted under the 103(a) rejection and further teach a) profiling the prospective customer's existing information technology environment, b) software programs for determining factors such as architecture, c) targeting existing components for modification, and d) providing an illustration to the prospect of a targeted component (e.g. the advantages of a Type 2 server (IBM S/390) over a Type 1 (UNIX OS servers) (see at least Fig. 7 (700); col. 3, lines 45-56; col. 4, lines 40-50; col. 11, lines 1-2; col. 12, lines 18-25; col. 22, lines 48-51). Ruffin et al., however, do not disclose displaying a pictorial representation of the existing network framework. It would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Ruffin et al. to display a pictorial representation of the existing network framework, since it is well within the skill to ascertain that displaying network frameworks as a pictorial representation using software

programs to visually represent a network framework is ubiquitous in the IT industry, and therefore serves as a visual presentation aid to help a customer comprehend a proffered solution.

- *Modifying the pictorial representation by indicia coding the targeted components:*

Ruffin et al. teach all the above as noted under the 103(a) rejection and further teach a) an automated process to ensure the prospective customer is briefed on relevant available services solutions, b) a tool comprising a database including sets of solution services and products associated with different types of business service or solution scenarios, and c) presenting solutions that modify the prospect's existing IT infrastructure. Ruffin et al., however, do not disclose modifying the pictorial representation by indicia coding the targeted components. It would have been obvious to one of ordinary skill in the art at time of the invention to modify the framework pictorial representation as noted above with indicia coding, since it is well within the skill to ascertain that indicia coding the targeted components associates the targeted components with solution services and products being recommended by the solutions provider, and therefore serves as a visual presentation aid to help the customer to better comprehend a proffered solution.

Pertaining to Claims 9-10, 12, and 16, Ruffin et al. teach the use of software running on a computer to automate the selling of products and services, and are rejected based on the rationale as noted above.

Pertaining to Claim 17, Ruffin et al. teach the use of logic to systematically analyze the prospective customer's framework for the purpose of proffering a product or service solution (see at least col. 6, line 62 through col. 7, line 3), and is rejected based on the rationale as noted above.

- 3. Claims 5-6 and 13-14 are rejected under 35 USC 103(a) as being unpatentable over Ruffin et al. (Paper #10, patent number 6,249,769), in view of Official Notice (Paper #20, regarding IT business services, hereinafter referred to as "ON1").**

Ruffin et al. teach all the above as noted under the 103(a) rejection and teach a method of providing solutions for IT services (e.g. network computing, e-business, ERP, enterprise business analysis), but do not disclose a full suite of IT services as subsets to these IT services. This examiner takes the position that it is old and well-known for IT services companies to offer, individually or in a business alliance capacity, a suite of IT business services as described in the instant claims. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Ruffin et al. to disclose a suite of business services to support IT clients as taught by ON1, in order to

Art Unit: 3625

serve as a comprehensive source for IT services, and thereby keep a foothold in the customer's business and increase sales.

Pertaining to Claims 13-14, Ruffin et al. teach the use of software running on a computer to automate the selling of products and services, and are rejected based on the rationale as noted above.

- 4. Claims 7 and 15 are rejected under 35 USC 103(a) as being unpatentable over Ruffin et al. (Paper #10, patent number 6,249,769), in view of Official Notice (Paper #20, regarding techniques to provide visual clarity to illustrations, hereinafter referred to as "ON2").**

Ruffin et al. teach all the above as noted under the 103(a) and teach a method of visually presenting to a prospective customer using indicia coding techniques to provide visual clarity to the illustration (e.g. textual coding, solid line coding, black color coding for lines, symbols to code different lines), but do not disclose texture coding and shading coding. This examiner takes the position that texture coding and shading coding are old and well-known techniques for providing visual clarity in displaying illustrations or graphs. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Ruffin et al. to use texture and shading coding as taught by ON2, in order to provide visual clarity to the illustration, and thereby help the customer to better comprehend the proffered solution.

Art Unit: 3625

Pertaining to Claim 15, Ruffin et al. teach the use of software running on a computer to automate the selling of products and services, and is rejected based on the rationale as noted above.

Art Unit: 3625

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

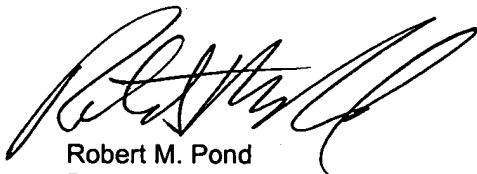
Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

703-872-9306 (Official communications; including After Final communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.



Robert M. Pond
Patent Examiner
November 1, 2004